



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Curry et al.

Application No.: 09/683,995 (CONF 2530)

Filed: 3/10/2002

Title: Email messaging program with built-in video
and/or audio media recording and/or playback
capabilities

Attorney Docket No.: 1049.002US1

Group Art Unit:
2155

Examiner:
Khanh Q. Dinh

Assistant Commissioner for Patents
Washington, D.C. 20231

APPEAL BRIEF

This Appeal Brief is organized in accordance with the requirements set forth in 37 CFR 1.192(c).

Real party in interest

The real party in interest in this patent application is Talkway, Inc., of Fremont, Calif. All the applicants have assigned their rights in the patent application to Talkway.

Related appeals and interferences

There are no related appeals or interferences to the present patent application.

Status of claims

Claims 1-24 are pending in the patent application. Claims 1, 8, 18, and 20 are independent claims, from which the remaining pending claims ultimately depend. None of the claims have been amended during prosecution. All the claims stand rejected, as summarized in the single issue presented for appeal, below.

Status of amendments

No amendments were made to claims 1-24 at any point during their prosecution.

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Summary of invention

The invention relates to having a single email messaging program at the side of a composing user that provides for the following functionality: the composing of a message, the recording of media (such as video, audio, as well as other types of multimedia), and the sending of the message and the media. That is, a *single* program at the side of the composing user performs all of this functionality.

The invention further relates to having a single email messaging program at the side of a receiving user that provides for the following functionality: the receiving of the message sent by the composing user, and the playback of the media upon the receiving user viewing the message. That is, a *single* program at the side of the receiving user performs all of this functionality.

The crux of the invention, therefore, is that a *single email messaging program* provides all of the functionality needed to compose an email message, record media associated with the message, and send the message and the media, at the composing user's side; and, to receive the message and the media, display the message, and playback the media, at the receiver user's side. That is, separate computer programs are *not* utilized by the invention (such as, for instance, one program to record media, and another program to send the media with an email message composed by the composing user); rather, only a *single* computer program is used to provide the functionality at either the composing user's side or the receiving user's side.

Issues

For the purposes of this appeal, there is a single issue: whether the US patent reference Budge et al. (US Pat. No. 6,564,248) anticipates the claimed invention – that is, whether Budge discloses a *single email messaging program* that provides for the composing of a message, the recording of media, and the sending of the message and the media (at the composing user's side), and for the receiving of a message, the displaying of the message, and the playback of the media (at the receiving user's side). The Examiner indicates that Budge discloses such a *single* email

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messaging program. Applicant, however, submits that Budge does *not* disclose a *single* email messaging program that provides the functionality at either the composing user's side or the receiving user's side.

Grouping of claims

For purposes of this appeal only, Applicant groups all pending claims 1-24 within a single group, and selects claim 1, as representative of these claims. Claim 1 reads as follows (all the claims are listed at the end of this brief):

1. A system comprising:

a network;

a first client having a first email messaging program installed thereon on which a composing user composes a message and records media, the first email messaging program sending the message to a receiving user over the network; and,

a second client having a second email messaging program installed thereon on which the receiving user receives the message over the network, the second email messaging program playing back the media upon the user viewing the message.

Argument

Claim 1 is an independent claim including a network, a first client, and a second client. Importantly, the first client has "a first email messaging program installed thereon *on which a composing user composes a message and records media*, the first email messaging program *sending the message to a receiving user over the network*". (Emphasis added) That is, the first email messaging program is the program on which a composing user both composes a message and records media, and is the program that sends the message. Similarly, the second client has "a second email messaging program installed thereon on which the receiving user *receives the*

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message over the network, the second email messaging program playing back the media upon the user viewing the message". (Emphasis added) That is, the second email messaging program is the program that receives the message, and plays back the media upon the receiving user viewing the message. Applicant submits that Budge does not disclose at least the emphasized limitations of claim 1.

Applicant notes that under the anticipation standard under 35 USC 102(b), "a claim is anticipated if *each and every limitation* is found either expressly or inherently in a single prior art reference." (In re Shepherd, 80 USPQ 495, 497 (CCPA 1949)) "A claim is anticipated only if each and every element *as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference." (MPEP, sec. 2131) Applicant submits that Budge does not anticipate claim 1 as to this standard.

Applicant submits that Budge does not disclose the limitation of a first email messaging program "on which a composing user composes a message and records media" and which "send[s] the message over the network" nor the limitation of a second email messaging program "receiv[ing] the message over the network" and "playing back the media upon the user viewing the message", such that Budge does not anticipate the invention of claim 1. Budge teaches and discloses an e-mail client 270 that is separate from both a video e-mail recorder 210 and a video e-mailer player 220, as depicted in FIG. 2B. The e-mail messaging program of Budge, the e-mail client 270, neither records media nor plays back the media that has been recorded. Rather, the recorder 210 and the player 220 are used for these purposes. Therefore, Budge does not anticipate the claimed invention of claim 1, because in claim 1 the first e-mail messaging program records media (whereas Budge's does not), and the second e-mail messaging program plays back media (whereas Budge's does not).

Furthermore, the mechanics of the e-mail client 270, the video e-mail recorder 210, and the video e-mail player 220 in Budge are disclosed and taught in such a way that Budge does not anticipate the claimed invention.

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The video e-mail recorder 210 receives as inputs video message data The video e-mail recorder 210 *also executes the Email client 270 and passes the video e-mail file to the E-mail client 270.*

. . . . The video e-mail player [220] *receives as inputs the video message file from the Email client 270* The video e-mail player 220 outputs video message data . . . and audio message data

(Col. 4, ll. 31-49) (Emphasis added) The video e-mail recorder 210 includes a recorder manager that "coordinates the various recorder functions *and interfaces with the Email client software residing on the PC.*" (Col. 5, ll. 3-5) The video e-mail player 220 "reads a video e-mail file 410, *originating from the resident Email client.*" (Col. 5, ll. 11-12)

The video e-mail recorder 210 in Budge thus records media, and then executes a separate program, the e-mail client 270, passing the recorded mail to the e-mail client 270. Whereas the invention of claim 1 is limited to a *single* program, an e-mail messaging program, *both recording media and sending a message* (including the media) over the network, in Budge these functionalities are divided into two separate programs: the video-email recorder 210 and the e-mail client 270. Furthermore, whereas the invention of claim 1 is limited to a *single* program, an e-mail messaging program, *both receiving the message over the network and playing back the media*, in Budge these functionalities are divided into two separate programs: the e-mail client 270 and the video-email player 220.

Therefore, Budge does not anticipate claim 1. It divides media recording and message sending functionality into two different programs, a video e-mail recorder and an e-mail client, whereas claim 1 is specifically limited to such functionality being encased within a single e-mail messaging program. Furthermore, Budge divides message receiving and media playback functionality into two different programs, an e-mail client and a video e-mail player, whereas claim 1 is specifically limited to such functionality being encased within a single e-mail messaging program. Budge does not render claim 1 unpatentable.

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Applicant notes that in the Final Office Action of February 12, 2004, the Examiner seemingly admits the exact argument that Applicant has been proffering throughout prosecution, as well as in this appeal. On page 8 of the Final Office Action, the Examiner states that:

Budge explicitly discloses a first client (sub-system 2 of fig.1) having a first email messaging program (i.e., using 50 fig.1 to provide the creation of video email messages and *transferring of those email messages to a conventional email client*)

(Emphasis added) That is, the Examiner states that reference number 50 in FIG. 1 of Budge discloses an email messaging program that allows for video email messages to be created, but that which then *transfers those email messages to a conventional email client* for sending the video email message to a receiving user. Such admission is essentially the argument that Applicant has made herein: that Budge discloses *a first computer program* that allows for video email messages to be created, and a *second computer program* (the conventional email client) to which those messages are transferred for sending to a receiving user. By comparison, claim 1 is limited to a *single computer program* that performs *both* of these functions. Therefore, Applicant asserts that Budge does not and cannot anticipate claim 1, as even the Examiner implicitly agrees.

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Conclusion

Applicant believes that the pending claims are in condition for allowance, and requests that they so be allowed, for the reasons described above.

Respectfully Submitted,



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Listing of claims on appeal

1. (original) A system comprising:
a network;
a first client having a first email messaging program installed thereon on which a composing user composes a message and records media, the first email messaging program sending the message to a receiving user over the network; and,
a second client having a second email messaging program installed thereon on which the receiving user receives the message over the network, the second email messaging program playing back the media upon the user viewing the message.
2. (original) The system of claim 1, further comprising a streaming media server, the first email messaging program uploading the media to the streaming media server upon the message being sent to the receiving user over the network, and the second email messaging program downloading the media from the streaming media server over the network upon the receiving user viewing the message.
3. (original) The system of claim 1, wherein the first email messaging program attaches the media as an attachment to the message upon the message being sent to the receiving user over the network, and the second email messaging program receives the media as the attachment to the message over the network.
4. (original) The system of claim 1, wherein the network comprises at least one of: the Internet, an intranet, an extranet, a local-area network (LAN), a wide-area network (WAN), a wired network, a wireless network, and a telephony network.

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5. (original) The system of claim 1, wherein each of at least one of the first client and the second client comprises: a desktop computer, a laptop computer, a cellular phone, a wireless phone, a set-top box, and a personal digital assistant (PDA) device.
6. (original) The system of claim 1, wherein the message comprises at least text.
7. (original) The system of claim 1, wherein the media comprises at least one of: audio, video, streaming audio, and streaming video.
8. (original) A system comprising:
a networking mechanism communicatively coupling the system to a network; and,
an email messaging program having at least a composing capability for a user to compose a message and record media associated with the message to send to another user over the network via the networking mechanism.
9. (original) The system of claim 8, further comprising an operating system on which the email messaging program runs.
10. (original) The system of claim 8, wherein the composing capability uploads the media to a streaming media server communicatively coupled to the network over the network via the networking mechanism upon the message being sent to the other user over the network via the networking mechanism.
11. (original) The system of claim 8, wherein the composing capability attaches the media as an attachment to the message upon the message being sent to the other user over the network

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12. (original) The system of claim 8, wherein the email messaging program further has a playback capability for the user to view messages received from other users over the network via the networking mechanism and play back received media associated with the messages received.

13. (original) The system of claim 12, wherein the playback capability downloads the media associated with one of the messages received from the streaming media server over the network via the networking mechanism upon the user viewing the one of the messages received.

14. (original) The system of claim 12, wherein the playback capability receives the media associated with one of the messages as an attachment to the one of the messages received over the network.

15. (original) The system of claim 8, wherein the networking mechanism comprises at least one of: an analog modem, an Integrated Services Digital Network (ISDN) adapter, a network adapter card, a network adapter chipset, a cable modem, a Digital Subscriber Loop (DSL) modem, a digital modem, and a wireless modem.

16. (original) The system of claim 8, wherein the message comprises at least text.

17. (original) The system of claim 8, wherein the media comprises at least one of: audio, video, streaming audio, and streaming video.

18. (original) A method comprising:
saving a message entered by a user by an email messaging program;
recording media associated with the message by the email messaging program;
uploading the media to a streaming media server over a network by the email messaging program; and,

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sending the message over the network by the email messaging program.

19. (original) The method of claim 18, further comprising:
receiving a second message over the network by the email messaging program;
in response to a user requesting the email messaging program to display the second message,
displaying the second message by the email messaging program;
downloading second media associated with the message from the streaming media server over the network by the email messaging program; and,
playing back the second media by the email messaging program.
20. (original) A method comprising:
saving a message entered by a user by an email messaging program;
recording media associated with the message by the email messaging program;
attaching the media to the message by the email messaging program; and,
sending the message over a network by the email messaging program.
21. (original) The method of claim 20, further comprising:
receiving a second message having attached thereto second media over the network by the email messaging program;
in response to the user requesting the email messaging program to display the second message,
displaying the second message by the email messaging program; and,
playing back the second media by the email messaging program.
22. (original) A computer-readable medium having instructions stored thereon for an email messaging program comprising:

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means for composing a first message by a first user and for recording first media associated with the first message to send to a second user over a network; and,

means for viewing a second message received from the second user over the network by the first user, and for playing back second media associated with the second message.

23. (original) The medium of claim 22, wherein the means for composing and for recording uploads the first media to a streaming media server communicatively coupled to the network over the network upon the first message being sent to the second user over the network, and the means for viewing and for playing back downloads the second media from the streaming media server over the network upon the first user viewing the second message.

24. (original) The medium of claim 22, wherein the means for composing and for recording attaches the first media as an attachment to the first message upon the first message being sent to the second user over the network, and the means for viewing and for playing back receives the second media as an attachment to the second message over the network.